

REMARKS

In response to the Examiner's objection to the claims, Applicant has amended the claims so that Claims 3-5 now depend from Claim 2, wherein the "plurality of digital modulators" and the "D/A converter" are recited. As such, antecedent basis for these elements in Claims 3-5 are now present. No new matter has been added. Please note, the amendment to the dependency of Claim 3 obviated amendment to Claim 4, its dependent claim.

Applicant wishes to bring to the Examiner's attention that the status of Claim 14, added by a preliminary amendment dated September 8, 2000, is not provided either in the Office Action Summary or in the body of the Office Action itself. Applicant respectfully requests the Examiner identify the status of Claim 14 with respect to its patentability.

Rejections Under §103(a).

Claims 1, 2, 6, 7, 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Xin *et al*, U.S. Patent No. 6,268,818 ("Xin") in view of Boesel *et al*, U.S. Patent No. 6,286,994 ("Boesel"). For the reasons presented below, however, reconsideration and withdrawal of the rejection respectfully is solicited.

With respect to Claims 1 and 10, the claims from which all other rejected claims ultimately (whether directly or indirectly) depend, the Examiner considers Xin as teaching an RF transmitting device having a baseband signal on I/Q channels having a digital unit for modulating the baseband signal and converting the modulated signal into an analog signal. The Examiner also contends that Xin discloses primary and secondary upconverting units which, respectively, upconvert the analog signal to an IF signal, and then to an RF signal. A transmitting unit then amplifies and transmits the RF signal.

The Examiner admits Xin fails to disclose a plurality of channel cards in the base station system Xin describes.

The Examiner fills this acknowledged gap, however, by citing Boesel, contending that Boesel teaches use of a plurality of channel cards in an RF transmitting device of a mobile radio communication base station system in a CDMA system.

The Examiner then contends that it would have been obvious to one skilled in the art to modify Xin to include the plurality of channel cards as taught by Boesel for use in a CDMA system.

Applicant respectfully disagrees and traverses the rejection. In order to establish a *prima facie* case of obviousness the references cited must teach every element recited in the claims and identify the necessary motivation to combine these elements. In re Rouffet, 149 F. 3d 1350; 47 USPQ2d 1453 (Fed. Cir., 1998). In short, the citations must “suggest the desirability of the combination” that is claimed. See MPEP 2143.01 at 2100-110, 111 and MPEP 2145 (j) 3 at 2100-127. Statements with regard to relevant skill in the art do not suffice to “bridge over gaps in substantive presentation of an obviousness case.” Al-Site Corp. v. VSI International, Inc., 174 50 USPQ2d 1161 (Fed. Cir. 1999). It is respectfully submitted that the cited references fail not only to disclose or teach each element of the Applicant’s claims, they also fail to provide the requisite suggestion *to do* what the applicants have done. For these reasons alone, the rejection of the claims is insufficient as a matter of law. Ex parte Levengood, 28 USPQ2d 1300, 1301-02 (BPAI 1993).

With reference to Xin and to Boesel, neither discloses structures to modulate baseband signals on 1/Q channels by each frequency assignment provided from the channel cards, as is recited in Claims 1 and 10. Xin and Boesel therefore also fail to disclose coupling

the digitally modulated signals by the frequency assignment, as recited in the claims.

Moreover, even if Xin and Boesel disclosed each and every feature of the claims, which they clearly do not, it is not understood what the Examiner considers to be the requisite suggestion or motivation to combine Xin and Boesel, so as to arrive at the claims presently under rejection.

Absent the relevant suggestion or motivation, existent and disclosed in the citations, the rejection cannot stand. “The mere fact the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP §2143.01 (2000 Ed., 2100-98) Citing, *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis original). In essence, the rejection boils down to an assertion that the references can be combined, not that there is any suggestion, motivation or disclosure to do so. A *prima facie* case under §103 requires far more than this.

Sufficient motivation to support the rejection requires the Examiner to demonstrate the kind of motivation which would have “*strongly motivated*” one to make a process as claimed, *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. Appeals. 1983). The type of motivation required is that which would have “*impelled*” one to do so, *In re Levensgood*, 28 USPQ2d at 1302, and the type of suggestion required is one that demonstrates the selection and combination “*should*” be made, *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. Appeals. 1964).

In comparison to these requirements, the Examiner gives no explanation whatsoever of the motivation supporting the combination underlying the rejection. The references should not be considered in light of the objectives achieved by the Applicants’ invention. *In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (“reliance on *per se* rules of obviousness is legally incorrect and must cease.”); and see MPEP §2116.01 at 2100-45 (Seventh

Edition, Rev. 1, Feb. 2000). Xin and Boesel, notwithstanding their lack of disclosure, furthermore exhibit no motivation or suggestion for any combination. Hindsight reasoning based on the Examiner's contention of what one of skill in the art would regard as obvious is no substitute for this requisite element of a prima facie case.

The combination of Xin and Boesel is demonstrably inadequate. The addition of Chester et al, (U.S. Patent 5,930,301) or of Atonio et al. (U.S. Patent 6,519,456) to reject Claims 3 and 4, add additional undue weight to a foundation that simply cannot even support the rejection of claims 1 and 10. For this reason alone, Claims 3 and 4 are allowable. Consequently, rejection of Claims 5 and 12 based on an alleged combination of Xin, Boesel, Chester and Atonio simply multiplies the flaws inherent in all other rejections, i.e., the lack of disclosure in Xin and Boesel, and the utter lack of any demonstrated motivation or suggestion to combine any of the cited patents, let alone pick and choose from elements disclosed between the four patents the Examiner advances to support the rejection. As such, because the combination of Xin and Boesel fail, further additional combinations of Chester, Atonio, or Chester and Atonio, must also fail. Favorable consideration and withdrawal of all rejections, and allowance of Claims 1-5, 6-7, 8-10, and 12-13.

CONCLUSION

In view of the foregoing arguments and amendments, Applicants submit that the instant application is in condition for allowance. Entry of the amendment and reconsideration and withdrawal of the rejection is respectfully solicited. If the Examiner has any questions regarding the application or this response, please contact the undersigned at the number provided.

Respectfully submitted,

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3/23/04

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